

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Michael C. Weaver et al.
 Application No. : 09/520,264
 Filed : March 7, 2000
 For : NETWORK-BASED SYSTEM AND METHOD FOR ACCESSING
 AND PROCESSING LEGAL DOCUMENTS

Examiner : Te Y. Chen
 Art Unit : 2161
 Docket No. : 110172.401
 Date : April 21, 2009

Mail Stop Appeal Brief - Patents
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

Commissioner for Patents:

This paper is in furtherance of the Notice of Appeal, filed in this case on November 24, 2008. Applicants timely filed an Appeal Brief on December 8, 2008 (hereinafter “Appeal Brief”).

A Notification of Non-Compliant Appeal Brief, dated March 23, 2009, (hereinafter “Notification”) was issued by the Examiner requesting correction and inclusion of a mapping of the corresponding material, structure, or acts described in the specification that correspond to each claimed function of the claims that are recited in “means plus function” or “means plus step” form in accordance with 35 U.S.C. §112, para. 6, namely claims 81-84. Specifically, in referring to independent claim 82, the Examiner stated,

It seemed that applicant try to map the recited “a meas for converting” in claim 82 to the units 312 and 318 in Fig. 3, however, *these units merely calls different controllers to identify different formates of files which does not performed the claimed converting functions* (e.g. Instant Specification: P 19, L 19-24). In

addition, the claims 81, 83 and 84 depending on claim 82 that were recited in form of “means plus function and “step plus function” ... the subject matters of ***these independent claims*** should be explained/mapped by referring to the specification with page and line number and to the drawings, if any. [SIC]

Notification, p. 2 (emphasis added).

In response to the Notification, Applicants are submitting below a corrected Section V, Summary of Claimed Subject Matter, **with revisions to independent claim 82.** Summaries of the other independent claims are repeated therein for convenience. (The Examiner has not requested any change with respect to the concise explanations previously provided under 37 CFR 41.37(c)(1)(v) for independent claims 60, 69, 75, and 85, which are not subject to 35 U.S.C. §112, para. 6.) Independent claim 82 is the *only* independent claim recited according to “means plus function format.”

As explained originally on the last paragraph of Page 8 of the Appeal Brief, Applicants note that **summaries of the claimed subject matter (under Section V) for the dependent claims recited in “means plus function” format are not required** because they are not being argued separately under 37 CFR 41.37(c)(1)(vii). Specifically, 37 CFR 41.37(c)(1)(v) requires that

...For each independent claim involved in the appeal and **for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section**, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

In Applicants’ Appeal Brief, dependent claims 81, 83, and 84 are not argued separately from independent claim 82; therefore, 37 CFR 41.37(c)(1)(v) does not require Applicants to provide summaries with mappings to the specification and figures and reference information for dependent claims 81, 83, and 84.

Further, with respect specifically to independent claim 82, Applicants have reviewed the previously provided mappings and have added additional information to assist the Examiner. Applicants note that the Examiner is incorrect in her description of the functions of Controllers 318-322 and her statement that these are not performing the claimed converting functions. (The Examiner incorrectly referred to units 312 and 318 in Fig. 3 as the means for

converting; however, the Specification and Applicants' previous mapping of claim 82 identified the means for converting as Controllers 318 and 322, not units 312 and 318.) Controllers 318, 320, and 322 are indeed part of the converting process – as they do not merely “identify different formats” as stated by the Examiner. Rather, Controllers 318-322 are part of the analyzing and extraction process that is part of converting the source electronic files to the read only extracted files stored in server unit 208, the metadata stored in server unit 204, and/or the indexed text content stored in server unit 202. As described in Applicants' specification, the recursive extraction process performed by units 312-316 includes as follows:

The conversion engine 134 includes a plurality of recursive engines 312-316 to process the file types 310, with this processing shown symbolically in Figure 3 by a single arrow from the file types 310 to the recursive engine 314. The recursive engines 312-316 “recursively” go through every path in a directory structure and extracts the files in each path, while still preserving the directory structure from which the files are taken. While three recursive engines 312-316 are shown in Figure 3, there can be any number of recursive engines used, with each recursive engine corresponding to a different file type 310. That is, for example, the recursive engine 312 extracts files having File Type 1 file extensions from directories, and the recursive engine 316 extracts files having File Type 2 from directories. The recursive engine 314 extracts files having non-email file extensions from directories. Because the individual files themselves may have attachments that are of a different file type (*e.g.*, an email may have a .doc attachment), one embodiment of the invention has recursive engines 312-316 that extract the files and their attachments together, without separating the attachment from the email. In another embodiment, the recursive engines 312-316 do perform a separation such that the email is extracted by the recursive engine 312 (or 316), and the attachment (non-email format) is extracted by the recursive engine 314, while the information noting the relationship between the email and attachment is preserved.

According to one embodiment, any one of the recursive engines 312-316 can first analyze the electronic legal documents provided by the informations [sic] systems 130 and/or storage media 132 to determine if these electronic legal documents include file types that it can extract.

Applicants' Specification, page 16, line 20 – page 17, line 12.

Then, once extraction has occurred, Applicants' Specification describes how the metadata is formed by converting these recursively extracted files:

Metadata, including conversational thread information, properties, and other electronic characteristics of the files (*e.g.*, electronic legal documents) are extracted by the controllers 318 and 322 and directed to an upload unit 332. The

upload unit 332 stores this electronic characteristic information in databases and tables 334 in the server unit 204.

The controller 320 functions similarly as the controllers 318 and 322, except that it processes non-email files. As with attachments to email files, these non-email files are sent by the controller 320 to the converter 328, which converts the files into the format of the converted files 330. Metadata, including directory path information, and other electronic characteristics of these non-email files are sent by the controller 320 to the upload unit 332 for storage in the database and tables 334 in the server unit 204.

To the extent that, while processing files, the controllers 318-322 identify files having different file formats, one embodiment of the conversion engine 134 allows the controllers 318-322 to call an appropriate controller that can process that different file format. For instance, if the controller 322 finds an email attachment having a format corresponding to a format that is designed to be processed by the controller 318 or by the controller 320, then the controller 322 can call these controllers to perform the required processing.

Applicants' Specification, page 19, line 6 – 24.

Accordingly, the “means for converting, including means for obtaining and storing in a second server unit using the conversion engine, said metadata from each of the recursively extracted electronic files” as recited in claim 82 does map to, for example, the controllers 318-322 which extract the meta-data and the upload unit 332 that stores the extracted metadata in the database and tables 334 in server 204.

V. SUMMARY OF CLAIMED SUBJECT MATTER (REVISED)

The present U.S. Application Serial No. 09/520,264 (hereinafter referred to as “the present application”) discloses embodiments that assist legal professionals (such as attorneys) in analyzing or otherwise processing electronic files that are subject to a legal proceeding, such as a “discovery” process. As explained in page 1, line 15 to page 2, line 23 of the present application, “discovery” is a document-intensive legal process in which one party (*e.g.*, a “requesting party”) frequently requests another party (*e.g.*, a “responding party”) to produce documents. The requesting party attempts to build its case by reviewing the requested documents and trying to locate highly significant individual documents (sometimes referred to as “hot documents”) that contain text or other information of an incriminating or otherwise significant nature. Typically, a large volume of documents are produced during discovery, thereby requiring significant time and effort to review and process such documents.

As explained on page 2, line 24 to page 4, line 24 of the present application, email and other forms of electronic files have gained the attention of legal professionals as a rich source of discoverable information. However, traditional methods of discovery involve printing out emails into paper hardcopies, and then manually reviewing and processing (such as indexing) such hardcopies in a manner similar to traditional paper documents. Printing email from its native electronic format into hardcopies results in the destruction of useful electronic characteristics of the emails, such as the lost of the conversational threads and other metadata.

Accordingly, embodiments disclosed in the present application provide legal professionals with access to electronic legal documents, via a network such as the Internet. These legal documents can include email documents, for example, that are produced in response to discovery requests and which are loaded into a database accessible via a server. Other examples of “electronic documents” can include electronic calendars/schedules, word-processing files, spreadsheets, text and graphics files, various application files, or any other type of electronic file or data that can be stored in a computer-readable storage media, and which can be subject to a legal proceeding or need to be otherwise reviewed/accessed. Once access has been granted to authorized legal professionals, the legal professionals can perform online search queries, indexing, data manipulation, and various other online operations to obtain and track results of

their document review. According to one embodiment, electronic characteristics (*e.g.*, metadata and other properties) associated with a native format of the electronic legal documents can be substantially preserved and used to perform various indexing and processing operations. *See, e.g.*, page 7, line 11 to page 8, line 2 of the present application.

According to one embodiment, electronic files to be processed for a legal proceeding (such as discovery) are received externally from an information system of a party involved in the legal proceeding. The electronic files are stored in a directory structure on a storage medium (such as CD) provided by the information system. *See, e.g.*, page 11, lines 15-22 and page 16, lines 15-18 of the present application. At least one recursive engine recursively goes through a plurality of paths of the directory structure to extract the electronic files, while preserving the directory structure from which the electronic files were taken. *See, e.g.*, page 16, lines 20-25 of the present application. The extracted electronic files are then converted to a searchable text format and into a read-only format and then stored, and the metadata associated with the extracted electronic files are also stored. *See, e.g.*, page 12, line 25 to page 13, line 8 of the present application. After the electronic files are stored and indexed in this manner, a legal professional can review or otherwise process the electronic files (such as marking documents as being relevant) after submitting keyword and/or metadata queries to retrieve a set of electronic files that match the search criteria in the queries. *See, e.g.*, page 13, line 24 to page 15, line 24 of the present application.

The following discusses independent claims 60, 69, 75, and 85. According to 37 CFR 41.67(c)(1)(v), a concise explanation of the subject matter in the independent claims has been set forth below with reference to the specification by page and line numbers, and to the drawings, if any, by reference characters. Accordingly, the following shows claims 60, 69, 75, and 85 together with the required reference information in brackets [] and *italicized*. Of course, the reference numbers and other bracketed information are illustrative only and are not intended to limit the claims only to the exact embodiments shown and described in the specification and figures of the present application.

60. A method in a computer system [112, 206, 122, 134, 120, 202, 204, and 208 in Figures 1-2; page 12, line 7 to page 13, line 23] for analyzing data produced for legal purposes, the method comprising:

receiving, from an information system [130 in Figure 1; page 11, lines 15-16] that is external to the computer system for analyzing data produced for legal purposes, a plurality of electronic files [310 in Figure 3; page 16, lines 6-19] that are stored in a data structure [132 in Figure 1; page 11, lines 17-19] arranged according to a directory structure [page 16, lines 15-18], that are subject to a legal proceeding [page 7, lines 18-19], and that are produced by at least one party involved in the legal proceeding [page 11, lines 16-17], said received plurality of electronic files having electronic characteristics that include metadata [page 19, lines 6-10];

recursively extracting the plurality of electronic files from a plurality of paths of said directory structure of the data structure that is received from the external information system [312-316 in Figure 3; page 16, line 20 to page 18, line 3];

storing the recursively extracted electronic files in a searchable text format in a first server unit [202 in Figures 2-3; page 13, lines 3-5 and lines 11-15], including storing textual content of the recursively extracted electronic files in the searchable text format in the first server unit [340 in Figure 3; page 13, lines 11-14; page 20, lines 1-5];

obtaining the metadata from each of the recursively extracted electronic files [318, 322, and 332 in Figure 3; page 19, lines 6-8], and storing the metadata in a second server unit [204 in Figures 2-3; page 19, lines 8-10], said storing including storing information of said directory structure of the received data structure so as to maintain said directory structure [page 16, lines 1-4 and lines 22-25; page 18, lines 4-5; page 21, lines 1-5];

converting the recursively extracted electronic files to a read-only format [324, 328, 326, and 330 in Figure 3; page 18, lines 9-20], and storing the electronic files in the read-only format in a third server unit [208 in Figures 2-3; page 13, lines 9-11];

receiving a request for electronic files having a specified text or metadata characteristic [page 13, line 24 to page 15, line 12; 510 in Figure 6]; and

processing the stored metadata to determine a set of electronic files having the specified text or metadata characteristic, thereby facilitating processing of the determined set of

electronic files for legal purposes [page 14, lines 9-21; page 28, lines 7-20; 416 in Figure 4; 512 in Figure 6].

69. A method in a computer system [112, 206, 122, 134, 120, 202, 204, and 208 in Figures 1-2; page 12, line 7 to page 13, line 23] for facilitating the analysis of data produced for legal purposes, the method comprising:

receiving, from an information system [130 in Figure 1; page 11, lines 15-16] that is external to the computer system for analyzing data produced for legal purposes, a plurality of electronic files [310 in Figure 3; page 16, lines 6-19] that are subject to a legal proceeding [page 7, lines 18-19], that are produced for purposes of the legal proceeding by at least one party involved in the legal proceeding [page 11, lines 16-17], and that are stored prior to being received by the computer system in a data structure [132 in Figure 1; page 11, lines 17-19] associated with the external information system, said received plurality of electronic files having electronic characteristics that include metadata [page 19, lines 6-10];

recursively extracting from a plurality of paths of a directory structure of the data structure the plurality of electronic files received from the external information system [312-316 in Figure 3; page 16, line 20 to page 18, line 3];

converting each of the recursively extracted electronic files to a searchable text format [134, 336, and 340 in Figure 3; page 20, lines 1-5; page 15, line 25 to page 16, line 4], and storing in a first server unit content of the converted files in the searchable text format [202 in Figures 2-3; page 13, lines 3-5 and lines 11-15];

obtaining and storing in a second server unit said metadata from each of the recursively extracted electronic files [318, 322, and 332 in Figure 3; page 19, lines 6-10; 204 in Figures 2-3; page 19, lines 6-10];

converting each of the recursively extracted electronic files to a format displayable on a display screen [324, 328, 326, and 330 in Figure 3; page 18, lines 9-20; 118 in Figure 1; page 8, lines 13-14], and storing the converted files in the displayable format in a third server unit [208 in Figures 2-3; page 13, lines 9-11]; and

responding to a request for at least one file having specified metadata or text characteristics using respectively at least one of the stored metadata or the stored content [page

13, line 24 to page 15, line 12; 510 in Figure 6; page 14, lines 9-21; page 28, lines 7-20; 416 in Figure 4; 512 in Figure 6].

75. An article of manufacture for a computer system [112, 206, 122, 134, 120, 202, 204, and 208 in Figures 1-2; page 12, line 7 to page 13, line 23], the article of manufacture comprising:

a computer-readable medium [120 in Figure 2; page 10, lines 7-17] having instructions stored thereon that are executable by a computer processor [318, 320, and 322 in Figure 3; page 18, lines 5-6; page 39, lines 1-2 of claim 28] to analyze data produced for legal purposes, by:

loading, from an information system [130 in Figure 1; page 11, lines 15-16; page 6, lines 10-11] external to the computer system having the machine-readable medium, a plurality of electronic files [310 in Figure 3; page 16, lines 6-19] that are subject to a legal proceeding [page 7, lines 18-19], that are produced by at least one party involved in the legal proceeding [page 11, lines 16-17], and that are stored in a data structure [132 in Figure 1; page 11, lines 17-19] associated with the external information system prior to being loaded at the computer system, said loaded plurality of electronic files having electronic characteristics that include metadata [page 19, lines 6-10];

recursively extracting the plurality of electronic files from a plurality of paths of a directory structure of the loaded data structure [312-316 in Figure 3; page 16, line 20 to page 18, line 3];

converting and storing in a first server unit content of the recursively extracted electronic files to provide a searchable text format [134, 336, and 340 in Figure 3; page 20, lines 1-5; page 15, line 25 to page 16, line 4; 202 in Figures 2-3; page 13, lines 3-5 and lines 11-15];

obtaining and storing in a second server unit said metadata from each of the recursively extracted electronic files [318, 322, and 332 in Figure 3; page 19, lines 6-10; 204 in Figures 2-3; page 19, lines 6-10];

converting the recursively extracted electronic files to a format displayable on a display screen [324, 328, 326, and 330 in Figure 3; page 18, lines 9-20; 118 in Figure 1; page 8,

lines 13-14], and storing the converted files in the displayable format in a third server unit [208 in *Figures 2-3; page 13, lines 9-11*].

85. A computer system for analyzing data produced for legal purposes, the computer system comprising:

at least one recursive engine [312-316 in *Figure 3; page 16, line 20 to page 18, line 3*] receiving, from an information system [130 in *Figure 1; page 11, lines 15-16*] that is external to the computer system for analyzing data produced for legal purposes, a plurality of electronic files [310 in *Figure 3; page 16, lines 6-19*] that are subject to a legal proceeding [page 7, lines 18-19], the electronic files produced by and belonging to at least one party involved in the legal proceeding [page 11, lines 16-17] and stored in a storage medium [132 in *Figure 1; page 11, lines 17-19*], said received plurality of electronic files having electronic characteristics that include metadata [page 19, lines 6-10], and said at least one recursive engine extracting the plurality of electronic files from a plurality of paths of a directory structure in the storage medium [page 16, line 20 to page 18, line 3];

a conversion engine converting the recursively extracted electronic files to a searchable text format [134, 336, and 340 in *Figure 3; page 20, lines 1-5; page 15, line 25 to page 16, line 4*], and obtaining metadata associated with the received electronic files [318, 322, 332 in *Figure 3; page 19, lines 6-10*];

a first server unit coupled to the conversion engine storing the converted electronic files in the searchable text format [202 in *Figures 2-3; page 13, lines 3-5 and lines 11-15*];

a second server unit coupled to the conversion engine storing the obtained metadata associated with the received electronic files [204 in *Figures 2-3; page 19, lines 8-10*]; and

another engine [122 in *Figures 1-2; page 12, lines 12-18*] in communication with the first and second server units receiving a request for electronic files having a specified metadata characteristic and processing the stored metadata to determine a set of electronic files having the specified metadata characteristic [page 14, lines 9-21; page 28, lines 7-20; 416 in *Figure 4; 512 in Figure 6*].

37 CFR 41.37(c)(1)(v) requires that “For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.” Accordingly, the following shows independent claim 82 together with the required reference information in brackets [] and *italicized*. Again, the reference numbers and other bracketed information are illustrative only and are not intended to limit the claims only to the exact embodiments shown and described in the specification and figures of the present application. No claims dependent upon claim 82 are being argued separately herein under the provisions of 37 CFR 41.37(c)(1)(vii), and so 37 CFR 41.37(c)(1)(v) does not require said reference information to be provided herewith for these dependent claims.

82. A computer system for analyzing data produced for legal purposes, the computer system comprising:

a first means [*134 in Figures 1 and 3; page 11, lines 19-22; page 15, line 25 to page 16, line 6*] for receiving, from an information system [*130 in Figure 1; page 11, lines 15-16*] that is external to the computer system for analyzing data produced for legal purposes, a plurality of electronic files [*310 in Figure 3; page 16, lines 6-19*] that are subject to a legal proceeding [*page 7, lines 18-19*], the electronic files produced as part of the legal proceeding by at least one party involved in the legal proceeding [*page 11, lines 16-17*], said received plurality of electronic files having electronic characteristics that include metadata [*page 19, lines 6-10*];

wherein said first means includes a means [*312-316 in Figure 3*] for recursively extracting the plurality of electronic files from a plurality of paths of a directory structure of the data structure provided from the external information system [*page 16, line 20 to page 18, line 3*];

wherein said first means for receiving includes a means [*134, 336, and 340 in Figure 3*] for converting the extracted electronic files to a searchable text format using a conversion engine [*page 20, lines 1-5; page 13, lines 11-14, page 15, line*

25 to page 16, line 4] and for storing the converted electronic files in the searchable text format in a first server unit [202 in Figures 2-3; page 13, lines 3-5 and lines 11-15], including a means [336 in Figure 3] for generating and storing in the first server unit textual content of the recursively extracted electronic files to provide the searchable text format [page 20, lines 1-5];

wherein said first means for receiving includes a means for converting [318, 320, and 322 in Figure 3, page 19, lines 6-17], including means [332 and 334 in Figure 3] for obtaining and storing [page 19, lines 6-17] in a second server unit [204 in Figures 2-3; page 19, lines 8-10, 14-17] using the conversion engine, said metadata from each of the recursively extracted electronic files;

wherein said first means for receiving includes a means [324 and 328 in Figure 3] for converting the recursively extracted electronic files to a read-only format using the conversion engine [page 18, lines 8-20], and for storing the converted electronic files in the read-only format in a third server unit [208 in Figures 2-3; page 13, lines 9-11, page 18, lines 15, 20];

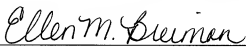
a second means [112 in Figures 1-2; 206 in Figures 2-3; page 13, lines 21-25] for receiving a request for electronic files having a specified text or metadata characteristic; and

a third means [122 in Figures 1-2; page 12, lines 12-18] for applying said request to the stored metadata to determine a set of electronic files having the specified text or metadata characteristic [page 13, lines 25-26; page 14, lines 9-21; page 28, lines 7-20; 416 in Figure 4; 512 in Figure 6].

Conclusion

Applicants respectfully request the Examiner to approve the modified Section V. Summary of Claimed Subject Matter of Applicants' Appeal Brief. Should any issues remain unresolved, Applicants urge the Examiner to contact Applicants' representative, at (206) 622-4900.

Respectfully submitted,
SEED Intellectual Property Law Group PLLC



Ellen M. Bierman
Registration No. 38,079

EMB:asl

701 Fifth Avenue, Suite 5400
Seattle, Washington 98104
Phone: (206) 622-4900
Fax: (206) 682-6031

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